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REMARKS

Claims 1-8 are pending in the instant application after this amendment adds new claim 8. Claims 1 and 5, and the specification are amended by this amendment. No new matter is introduced by the amendments, which find support throughout the specification and figures. In particular, the amendment to the specification merely clarifies the distinction between the known method and the claimed invention, which is described elsewhere in the specification, and at least at page 5, lines 15-18. In view of the amendments and the following remarks, Applicants respectfully request that the pending claims be allowed.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Publication No. 2003/0189912 to Laitinen et al. (hereinafter referred to as Laitinen) in view of United States Patent No. 5,701,585 to Kallin et al. (hereinafter referred to as Kallin). Applicants respectfully traverse.

Claim 1 relates to a method of handover in a multimode mobile telecommunication network. The method of amended claim 1 includes *determining that a mobile terminal is in a saturated cell, and after the determining operation, and in order to initiate a handover, sending by the network to a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching service.* The method of claim 1 also includes performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information, and sending to the network the measurements performed in the previous step. In the method of amended claim 1, *the network sends to the mobile terminal the first group of system information via the first channel after the performing measurements step.*

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The Office Action relies on Laitinen's apparent disclosure of the measurement and reporting of the 3G cells being performed immediately upon receipt of the 3G neighbor cell list (Laitinen; para. 0005 and para. 0058). The Office Action relies on Kallin as disclosing the feature of performing measurements in at least one additional neighboring cell, and sending to the network the measurements performed in the cell in a distinct message from the transmission of the measurements performed in the at least one neighboring cell. The Office Action asserts that Laitinen discloses the network sending to the mobile terminal the first group of system information via the first channel after the performing measurements step at paragraphs 0006-0008, 0011, 0022, and 0025 in a disclosure apparently relating to a mobile station transitioning from GPRS dedicated mode to a GSM dedicated mode. (Office Action; page 4, lines 6-12).

However, the description in Laitinen, and as characterized by the Office Action, relates to measurements in packet broadcasting cells which are made *prior* to the initiation of a handover. As recited in the unamended claim, the performing of measurements are made "to initiate a handover", and therefore, these measurements are made after the initiation of a handover, in stark contrast with the apparent disclosure in Laitinen asserted in the Office Action. In the interest of expediting prosecution, this feature is moved from the preamble of the claim to the body of the claim. In the amended claim, the measurements based on the second group of system information is made *after the determining operation and in order to initiate a handover*. The Office Action states that "when the mobile station transitions from a GPRS dedicated mode to a GSM dedicated mode, the MS immediately made measurements on packet system information (PSI3) received while in GPRS dedicated mode" (Office Action; page 4, lines 8-10). However, absent from this characterization is that the measurements made in the GPRS mode are apparently made prior to a determination of saturation and prior to the initiation of a handover. It

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is respectfully submitted that neither of Laitenen nor Kallin disclose or suggest this feature, and therefore the rejection of the claims should be withdrawn.

The Office Action states that "both references are in the same field of endeavor of mobile assisted handoff comprising signal quality measuring of cells" (Office Action; page 2, bottom). The Office Action further asserts that "the use of measuring and reporting the quality levels of each of the cells assigned to [a] mobile terminal is conventional and well known in the art" (Office Action; page 3, top). The Office Action does not provide any additional support for the motivation to combine the references. It is respectfully submitted that there is no motivation provided in Kallin to suggest the combination with Laitenen, and therefore, the rejection is improper, and amended claim 1 is allowable over the reference.

Claims 2-4 and 6 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Claim 5 recites features similar to claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable.

Claim 7 depends from claim 5 and is therefore allowable for at least the same reasons as claim 5 is allowable.

New claim 8 relates to a handover method for a mobile terminal in a mobile communication network. The method of claim 8 includes, *inter alia, in response to a determination that the mobile terminal is in a saturated cell, sending by the network to the mobile terminal packet system information via a packet switching channel, the packet system information including GPRS frequencies for neighboring cells, and performing measurements by the mobile terminal, based on the packet system information, in a first neighboring cell.* The method of claim 8 also includes sending to the network a result of the

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measurements performed on the first neighboring cell, further performing further measurements by the mobile terminal, based on the packet system information, in at least one further neighboring cell, and further sending to the network a further result of the further measurements performed on the at least one further neighboring cell, the further sending being performed in a message distinct from the step of sending to the network the result of the measurements. Claim 8 also includes *initiating a handover according to the result of the measurements, and after the step of performing measurements by the mobile terminal, the network sends to the mobile terminal circuit system information via a circuit switching channel, the circuit system information including GSM frequencies for neighboring cells.*

Therefore, claim 8 recites features similar to claim 1 and is therefore allowable for at least the same reasons as claim 1 is allowable.

CONCLUSION

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action. Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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